



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,831	06/15/2001	Catia Bastioli	13929/123411	7489

7590

04/03/2002

Brya Cave McPheeters & McRoberts  
245 Park Avenue  
New York, NY 10167

EXAMINER

RAJGURU, UMAKANT K

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/03/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

**Period for Response**

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- ☐ Responsive to communication(s) filed on Jun 15, 2001 (paper nos 5 & 6)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-23 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-23 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 6
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

**Office Action Summary**

Art Unit: 1711

1. Claims 1-23 are under examination .
2. A preliminary amendment (paper no 5) has been filed on June 15, 2001.

In the said amendment, it is stated that attached annexes to the IPER should be substituted for pages 19-22 of WO 00/17270. There are no annexes received and therefore it is not known what the applicants intend to do.

In the same amendment, claims 3&23 are supposed to have been amended. No amendments for these claims appear in the submitted papers. Furthermore, the numbering of the claims 3-6, 13-19 and 21-23 is erroneous and subject matter of amend<sup>ed</sup> claims 11&12 does not match with that of unamended claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 is indefinite because it is not known what the recitation "wherein the starch complex..... in the case of hydrophobic biodegradable polymers" means. Furthermore use of

*Met  
Dec 20, 2002*

Art Unit: 1711

adjective "the" in line 13 before "aliphatic" is confusing because these moieties have never been referred to earlier. Terms "polyamides-polyesters", "polyurethane-polymides", "polyurea-polyesters" are indefinite because it seems that each one is meant to represent a copolymer. If it is so, then proper terminology may "amide ester copolymers" etc.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastioli et al (WO 98/20073 in view of Corvasce et al (EP 0795581) and Bastioli et al (EP 0965615).

(All references are of record on page PTO-1449, paper no. 6).

Bastioli '073 discloses biodegradable polymer compositions comprising starch and a thermoplastic polymer. The polymer can be an aliphatic-aromatic copolyester, polyester-amide or

Art Unit: 1711

polyester-urethane, all of which read on those in instant claim 1. Compositions are used to make films, laminated paper bags etc. (p. 51, claims 41-43).

Bastioli fails to disclose a starch complex and coupling agents.

Corvasce discloses a rubber composition containing a starch/plasticizer composite, an elastomer, (optionally a couplet) and optionally a carbon black as well as silica (abstract). On page 2, line 53 to page 3, line 16, several suitable <sup>coupling</sup> ~~coupling~~ agents are mentioned. They read on those that are instantly claimed.

Bastioli '615 discloses complexed starch-containing compositions having high mechanical properties. Starch forms complexes with synthetic polymers such polyethylene, vinyl alcohol or polyethylene acid acrylate (p. 2, lines 46-47) and such complex acts as a compatibility-inducer or phasing agent.

Therefore, it would have been obvious from the teachings of Corvace, to use coupling agent/s in the composition of Bastioli ('073) in order to improve mechanical strength of the product made out of that composition. It would have been obvious, from the teachings of Bastioli ('615) to use a complexed starch in lieu of starch in the composition of Bastioli ('073) since a complexed starch imparts better resistance to ageing.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

Art Unit: 1711

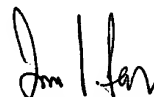
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310/9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Examiner U.K. Rajguru/ng

March 28, 2002



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700